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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,631	10/30/2003	Javier Saenz	IGT1P419BX1/AP-014B CIP	3077
22434 7590 04/28/2009 Weaver Austin Villeneuve & Sampson LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			EXAMINER LE, KHANH H	
			ART UNIT 3688	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/699,631	Applicant(s) SAENZ, JAVIER	
	Examiner KHANH H. LE	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 09, 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 21-29 is/are rejected.
- 7) ☒ Claim(s) 21-27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>Feb. 10, 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 09, 2009 has been entered.

Claims 1-25 were pending. Claims 26-29 have been newly added. Claims 10-20 are cancelled. Thus claims 1-9 and 21-29 remain in the application. Independent claims 1 and 21 have been amended.

Claim objections

2. **Claims 21-27 are objected to because of the following informalities:**

Claim 21 line 8: "said central server" lacks antecedent basis. Claims 22-27 are objected as dependents of claim 21.

Claim 27, line 3: "said service" lacks antecedent basis.

Appropriate correction is required to all the above.

Claim Rejections - 35 USC § 112, first and second paragraphs.

3. **Prior rejections of claims 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, and under 35**

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U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, are withdrawn as moot.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-9 and 28-29 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.

Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter.

A method claim must meet a specialized, limited meaning to qualify as a patent-eligible process claim. As clarified in *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008), the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. This is called the

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"machine-or-transformation test". There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

Here, claim 1 claims a method for selecting awards in a server (which denotes a machine) in the preamble, however the preamble is given little patentable weight because none of the steps in the body of the claim necessarily ties back to the preamble.

That is, "providing a floor diagram...", "maintaining a patron database", "receiving substantially current transaction activity...", "assigning a profile to said first patron", "matching two or more awards to said profile", "sorting the two or more awards .." do not specifically or inherently relate to the server of the preamble. (That is, e.g. even though some type of machine seems needed to maintain the database, it also appears from the claim that a person can do the searching through the database).

Also the recited steps of "maintaining a database, receiving data of current transaction activity, displaying information on first and second interface" appear to be mere insignificant data gathering or outputting, i.e. insignificant extra solution activities that will not transform an unpatentable principle into a patentable process. (It is noted a display device coupled to the server in the first displaying step is recited but as noted earlier this is an insignificant data outputting step). As stated above, the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. In other words, the machine's involvement should be central to the purpose of the claimed method and there should be a nexus between the machine and the steps so that it is a specific application of the underlying fundamental principle. Here, for example, if the central part of the invention is profiling patrons based on past and current transactions, matching awards to the profiles and sorting the awards based on some

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criteria, then at least these main steps should be claimed “using a computer” or server or like language.

Thus method/process claim 1 is deemed not tied to another statutory class of invention (e.g. a particular a machine) as required. Nor is there any transformation of underlying subject matter (such as an article or materials) to a different state or thing. Thus the claimed invention is deemed directed to non-statutory subject matter.

Claims 2-9 and 28-29 suffer the same defects.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-9, and 21- 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boushy et al. US 6003013 in view of Pierce US 6332126 and Walker 20030027635.

Independent claims 1, 21 and dependent claims 8, 9, and 28:

BOUSHY discloses:

A computer-implemented method and system for selecting awards to be offered to patrons of an establishment (abstract), the method comprising:

maintaining a patron database storing patron information relating to a plurality of patrons and historical transaction information involving said patrons (abstract; col. 9 lines 52-67; Fig 3 item 212;) connected to a central server unit (fig. 1 items 112 , 114 and associated text: database server; marketing server; Fig 2A: components of server 112) with a processor and a memory (inherent)

monitoring substantially current transaction activity of said plurality of patrons (abstract: updated customer accounts; Figures 3 and 4 and associated text) and storing in current activity database;

regularly assigning a profile (i.e. assigning then updating the profile) to said first patron (col. 5 lines 21-24; col. 10 lines 54-61), by a profile assignment module executable by said server processor, based at least upon portions of said historical transaction information pertinent to said first patron and said substantially real time or current transaction activity (abstract; col. 9 lines 52-67; also col. 9 line 67 to col. 10 line 2);

by an award matching module executable by said server processor, matching 2 or more awards to ones of said profiles (abstract, last line); and

offering said one or more awards to ones of said plurality of patrons assigned to said ones of said profiles (abstract, last line; Figure 4; Fig. 4 item 454 and associated text).

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(Note: Boushy also discloses
generating and receiving a script containing information relating to conveyance of awards
(e.g. col. 12 lines 8-12: the number of points, based on an newly determined status, is determined
; this information about the points to be offered to customer is the script);

BOUSHY further discloses wherein said historical transaction information is reflective
of prior participation of said plurality of patrons in gaming activity managed by said business
establishment (abstract) and (claim 20) wherein said profile is selected as a function of
participation of said first patron in said gaming activity and in current gaming activity (abstract:
updated profile; col. 9 lines 55-67).

Boushy discloses several offers based on updated profiles but **does not specifically disclose** *“based upon at least the historical transaction information involving said patrons including the first patron and the current transaction activity of at least the first patron, **sorting the two or more awards according to a likelihood of the first patron accepting each award; and outputting, based upon said sorting, at least one recommendation of an award to offer to the first patron.”***

However Pierce, in the same computer-based targeted discount and incentives art, **discloses consumer transaction histories used to match qualified consumers to targeted merchant discount offers.** Offers are automatically prioritized based on their expected value to consumers and consumers receive the highest priority offers for which they qualify. (abstract; col. 2 lines 34-37). The default prioritization can be altered or overridden by the merchants system (abstract). Pierce also discloses, after matching offers to consumers, automatically notifying them of the best offers for which they qualify (col. 4 lines 55-57; Figure 1.8). In doing so, Pierce discloses the goal is to offer patrons the offers in which they will be most interested (Pierce, col. 2 lines 18-24).

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The offers prioritizing in Pierce reads on offers sorting as claimed, (i.e. in order of importance, see definition per [http:// dictionary.reference.com/browse/prioritize](http://dictionary.reference.com/browse/prioritize), printout provided with the last Office Action). Since Pierce teaches patrons will be most interested in these offers, Peirce thus discloses ”sorting the two or more awards according to a likelihood of the first patron accepting each award” as claimed because logically patrons would be likely to accept what they are “most interested” in.

Thus it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a “PHOSITA”) to add the above Peirce’s teaching of prioritizing offers to Boushy to offer patrons the best offers in which they will be most interested (Pierce, col. 2 lines 18-24).

The combination of BOUSHY in view of PEIRCE does not explicitly disclose recommendations. However Pierce’s notifying of the best prioritized offers reads on recommendations. This is because the system or system operators can override the default prioritization (see abstract), thus this prioritized list only acts as a list of suggestions or recommendations of offers to present to the consumer. The motivation to add this limitation of Pierce to Boushy is to allow some degree of flexibility to the system operator in making the offers.

Further it would have been obvious to combine to combine the recommendations of Peirce to Boushy since the claimed invention is merely a combination of old elements (recommendations of offers of Pierce and offers made in Boushy), and in the combination each element merely would have performed the same function as it did separately (i.e. the offers would just have been recommended instead of being imposed), and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Boushy and Pierce does not disclose:

a hand-held display device the use of which is limited to operators of the gaming establishment

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with first interface and said second interface on the display device,

wherein said first interface comprises a visual indicator to display a location of a first patron rendered on the floor diagram of said gaming establishment

wherein said second interface displays, based upon results of said sort, information indicating at least one recommendation of a first award from the matched awards to offer to ones said first patron

and data for generating a floor diagram of the gaming establishment including a relative position and an arrangement of gaming devices and gaming tables within the gaming establishment.

However Walker, in the same gaming and offers arts, discloses:

a hand-held display device the use of which is limited to operators of the gaming establishment (e.g. Figure 1 item 140: representative device; Fig 5 item 570; 580; [0046]; [0076])

with first interface and said second interface on the display device,

wherein said first interface comprises a visual indicator to display a location of a first patron rendered on the floor diagram of said gaming establishment ([0186]: map of casino on rep device);

wherein said second interface displays, information indicating at least one recommendation of a first award from the matched awards to offer to ones said first patron ([0114] last 4 lines) the server provides list of offers matched to particular players, subject to override by representative);

and server generating data for generating a floor diagram of the gaming establishment including a relative position and an arrangement of gaming devices and gaming tables within the gaming establishment (inherent in order to generate the map shown to the representative device, see paragraph [0186]).

Thus it would have been obvious to a PHOSITA to add the representative device of Walker to Boushy and Pierce to provide another convenient method of displaying offers to patrons, by mobile service attendants, as taught by Walker. In this case, it would have been obvious to a PHOSITA that the sorted and matched offers or recommendations as taught by Walker and Pierce would also have been displayed. *(Note that Walker also teaches (at [0114] last 4 lines) the server provides list of offers matched to particular players, subject to override by representative. Since the representative is on the floor and can observe the player before making the offer, see e.g. [0076], her selection of which offer reads on sorting the list of matched suggestions according to a likelihood of acceptance. Since Walker teaches displaying the manual sort on the device, while Pierce teaches sorting automatically, it would have been obvious, in the system of Boushy, Pierce and Walker, to display the automatic sort on the Walker's device).* It would have been obvious to a PHOSITA to add the mapping functionality of the representative device of Walker and its necessary mapping data generation to Boushy and Pierce so to provide the useful customer location function as taught by Walker.

(Note: Walker also discloses:

A computer-implemented patron award system for a gaming establishment comprising:

a) a patron database (e.g. Figure 4 item 455 and associated text; Figure item 580 “likes to play golf” reads on patron characteristics or profiles; e.g. [0159]);
in which is maintained patron information relating to a plurality of patrons and historical transaction information (e.g. Figure 5 item 580 “staying at hotel”) involving said patrons;

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b) a current activity database for storing substantially current transaction activity information (e.g. Figure item 580 “last 10 spins have been losing outcomes”) for said plurality of patrons;

c) a server unit operatively connected to said patron database and said current activity database, said central server including:

a processor and a memory associated with said processor,
wherein said memory further includes:

a profile assignment module executable by said processor, said profile assignment module being disposed to regularly assign (i.e. update) profiles to said plurality of patrons (e.g. Figure 4 item 455 and associated text; Figure item 580 “likes to play golf” reads on patron characteristics or profiles; e.g. [0159]);[0048]: representative can view player’s profiles (e.g. “hobbies”) and update player’s profiles via her PDA, e.g. as to acceptance of offers;

an award matching module executable by said processor, said award matching module operating to match awards to ones of said profiles ([0114] last 4 lines: server provides list of offers matched to particular players, subject to override by representative);

logic executed by the processor designed or configured to,

based upon at least the historical transaction information related to the plurality of patrons and said substantially current transaction activity of said plurality of patrons, provide the matched awards to a first patron (of said plurality of patrons assigned to said ones of said profiles) (e.g. [0092]); and display on mobile representative device with 1st and 2nd interface as discussed above).

Claims 2, 22-23:

The combination of BOUSHY in view of PEIRCE and Walker discloses a method and/or system as in claims 1, or 21 above and BOUSHY further discloses defining a plurality of profiles associated with a corresponding plurality of profile valuations, said assigning further including selecting said profile from said plurality of profiles.
(col. 9 lines 52-67: e.g. VIP customers).

Claims 3, 24, 26:

The combination of BOUSHY in view of PEIRCE and Walker discloses a method and/or system as in claims 1, or 21 above and BOUSHY further discloses defining a plurality of awards, said matching further including selecting said award from said plurality of awards based upon a profile valuation of said profile and a value of said award (abstract: distinguished (i.e. more valuable) services for special status (i.e. is higher valuation) customers; col. 12 lines 8-12, 20-22: different levels of points; col. 12 lines 50-55: different levels of comps).

Claims 4, 25:

The combination of BOUSHY in view of PEIRCE and Walker discloses a method and/or system as in claims 1, or 24 above and BOUSHY further discloses wherein said profile is characterized by a profile valuation (col. 9 line 2 to col. 10 line 2 : VIP or Premier customers profiles, “worth to the casino” or “theoretical win value” read on profile valuations). Boushy also discloses awards commensurate with customers’ expenditures and her worth to the casino (e.g. based on her “theoretical win value” to the casino) (col. 14 lines 9-25).

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However BOUSHY does not specifically disclose said award matched to said profile is being valued at less than or equivalent to said profile valuation.

However, businesses are not in the business to lose money. Since giving awards values higher than what the business can make of the customer (e.g. based on her “theoretical win value” to the casino) is losing money, it would have been obvious to the PHOSITA to add to the combination of BOUSHY in view of PEIRCE and Walker to give an award matched to said profile being valued at less than or equivalent to said profile valuation only, for the above stated goal. Giving more would be inconsistent with Boushy’s goal of giving “commensurate awards” (col. 14 lines 22-24).

Claim 5:

The combination of BOUSHY in view of PEIRCE and Walker discloses a method and/or system as in claim 1 above and BOUSHY further discloses customer’s preferences are collected (col. 9 lines 54).

But neither BOUSHY nor PEIRCE explicitly disclose wherein said matching includes considering award preferences of said patron or plurality of patrons. However since one usually is more receptive to offers that one likes, it would have been obvious to a PHOSITA to add to BOUSHY an offer based on the consumer preferences to increase the odds that the offer would be accepted. These personalized awards would enhance the customer's overall experience with the business and the awards process and might make him or her more likely to return, a goal of Boushy (col. 10 lines 49-53).

Claim 6:

The combination of BOUSHY in view of PEIRCE and Walker discloses a method as in Claim 5 above and BOUSHY further discloses wherein said matching further includes considering current conditions (col. 13 lines 29-32). (Note “current conditions” also reads on

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current activities of the customers, which as stated in discussions of previous claims above, determine level of awards as points and/or comps).

Claim 7:

The combination of BOUSHY in view of PEIRCE and Walker discloses a method and/or system as in claim 5 above of matching awards based on customers preferences and further BOUSHY discloses the system monitors customers reactions to offers (redemptions) for analysis to better target subsequent offers (col.14 lines 43-49 and lines 58-60). Since one is more likely to accept an offer that one likes, accepting a particular award is some indication of one's preference for that award. Thus at col.14 lines 43-49 and lines 58-60, BOUSHY discloses matching awards wherein "the award preferences are based at least in part upon reaction of said first patron to other awards previously offered to said first patron".

Claims 27 and 29:

The combination of Boushy in view of PEIRCE and Walker discloses a method and/or system as in claims 1, or 24 above. BOUSHY in view of PEIRCE does not, but Walker discloses wherein said logic is further designed or configured to generate a script containing information that describes how to deliver said first award to said first patron and wherein said logic is further configured to output said script to the display device (e.g. [0076]; [0168]: "prompts" reads on scripts) .

Thus it would have been obvious to a PHOSITA to add such functionality to the system of Boushy and PEIRCE to help the representatives make effective offers presentations as taught by Walker.

Response to Arguments

8. Applicant's arguments with respect to claims 1-9 and 21-29 have been carefully considered but are moot in view of the new ground(s) of rejection presented above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mothwurf US 6712695 B2 discloses jackpots given in real time to casino tables selected based on their locations and other criteria.

Nelson et al, US 20070271113 discloses Dynamic Casino Tracking And Optimization.

Ragsdale-Elliott US 20020147647 discloses wireless maitre d' system for menu orders. including a pager unit configured to fit in the palm of a waiter/waitress with multi-line scrolling and buffer capabilities for receiving and transmitting messages.

McConnell 20030149633 discloses sales order process and system; wireless user and attendant devices.

Faris 6677858 et al. (2001) discloses tracking patrons in space/time to offer incentives to them on many different wireless devices.

Hammond 20020133418 portable customer device with menu to select from.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHANH H. LE whose telephone number is 571-272-6721. The Examiner can normally be reached on Monday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314)..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 27, 2009

/Khanh H. Le/

Examiner, Art Unit 3688